

## REMARKS

After entry of this amendment, claims 1-27 remain pending. In the present Office Action, claims 1-15 were rejected under 35 U.S.C. § 101. Claims 1-4, 12, 15-19, and 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Yamagami et al., U.S. Patent No. 6,836,830 ("Yamagami"). Claims 5-11, 13-14, and 20-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamagami in view of Ito et al., U.S. Patent Application Publication No. 2002/0016792 ("Ito"). Applicant respectfully traverse these rejections and request reconsideration.

### Art Rejections

Applicant respectfully submits that claims 1-27, as originally filed, each recite a combination of features not taught or suggested in the cited art. To further highlight the existing distinctions in the claims, Applicant has amended independent claims 1, 16, and 27 for clarification purposes only. For example, claim 1 recites a combination of features including: "modify at least a first attribute corresponding to a first volume, the first volume corresponding to a computer system's backup state, wherein the computer system's backup state was previously saved in a backup operation, and wherein the first attribute is modified in the computer system's backup state subsequent to the backup operation; and subsequent to modifying the first attribute, cause the first volume with the modified first attribute to be created on a first computer system as part of a restore of the computer system's backup state to the first computer system."

Yamagami does not teach or suggest the above highlighted features. Rather, Yamagami teaches modifying a volume as part of making a backup. For example, Yamagami teaches "This embodiment supports the command for changing the attribute of the volume so that the user volume for saving the user data and the working volume for storing the saving data are replaced in use. This makes it possible to change the number of the working volumes according to a multiplicity of the required copy request and effectively utilize the working volume resources." (Yamagami, col. 17, lines 28-34) Thus, this section of Yamagami (cited by the Office Action with regard to claim 1) relates to changing volume resources to make a copy of the volume. This is further

supported by Yamagami's statement of the field of the invention: "a method of backing up data stored in a storage unit provided in a computer system. More particularly, the present invention relates to a method of backing up data from a disk system into a storage medium for a backup without having to interrupt I/O processing of an application program running on a computer." (Yamagami, col. 1, lines 8-12).

In fact, Yamagami appears to be focused on the creation of backup copies, without touching on recovery from a backup copy at all. The Office Action cited col. 4, lines 41-47, with regard to restoring. While this section does mention controlling a restore operation, no details are provided. The sections cited to allegedly teach changing volume attributes all occur as part of the backup operation. There is no teaching of changing a volume attribute subsequent to the backup operation, and creating the volume with the modified attribute in a restore operation.

For at least the above stated reasons, Applicant submits that claim 1 is patentable over the cited art. Claims 2-15, being dependent from claim 1, are similarly patentable over the cited art for at least the above stated reasons. Each of claims 2-15 recite additional combinations of features not taught or suggested in the cited art.

Claim 16 recites a combination of features including: "modifying at least a first attribute corresponding to a first volume, the first volume corresponding to a computer system's backup state, wherein the computer system's backup state was previously saved in a backup operation, and wherein the modifying is performed in the computer system's backup state subsequent to the backup operation; and subsequent to the modifying, initiating a restore of the computer system's backup state, including the first volume with the modified first attribute, to a first computer system, wherein the restore comprises creating the first volume on the first computer system." The same teachings of Yamagami highlighted above with regard to claim 1 are alleged to teach the features of claim 16. Applicant respectfully submits that Yamagami does not teach or suggest the above highlighted features, either. Accordingly, Applicant submits that claim 16 is patentable over the cited art. Claims 17-26, being dependent from claim 16, are similarly

patentable over the cited art for at least the above stated reasons. Each of claims 17-26 recite additional combinations of features not taught or suggested in the cited art.

Claim 27 recites a combination of features including: "a first computer system configured to modify at least a first attribute of a first volume corresponding to a computer system's backup state, wherein the computer system's backup state was previously saved in a backup operation, and wherein the first attribute is modified in the computer system's backup state subsequent to the backup operation, and wherein the first computer system is configured to subsequently initiate a restore of the computer system's backup state, including the first volume with the modified first attribute." The same teachings of Yamagami highlighted above with regard to claim 1 are alleged to teach the features of claim 16. Applicant respectfully submits that Yamagami does not teach or suggest the above highlighted features, either. Accordingly, Applicant submits that claim 16 is patentable over the cited art.

#### Section 101 Rejection

Claims 1-15 were rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. Particularly, the Office Action alleges that the computer accessible medium includes signals, citing the specification, page 15, line 21-page 16, line 10. (See Office Action, page 2, item 1). Applicant respectfully disagrees. The cited portion of the specification includes: "a computer accessible medium may include ... media accessible via transmission media or signals such as electrical, electromagnetic, or digital signals, conveyed via a communication medium such as a network and/or a wireless link." Thus, the specification does not define the computer accessible medium as including signals, but rather media that are accessible via signals. For example, the media may be accessed over a network or wireless link, and thus need not be part of the computer or inserted into the computer to be accessible to the computer. Accordingly, Applicant respectfully submits that the computer accessible medium is statutory.

## CONCLUSION

Applicant submits that the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5760-20600/LJM.

Also enclosed herewith are the following items:

- Return Receipt Postcard
- Petition for Extension of Time
- Request for Approval of Drawing Changes
- Fee Authorization Form authorizing a deposit account debit in the amount of \$ for fees (      ).
- Other:

Respectfully submitted,



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Date: 4/7/06